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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/483,766	01/19/00	MAHE V	ROC-17

HM12/1019
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EXAMINER	
FUBARA,B	
ART UNIT	**PAPER NUMBER**
1615	4

DATE MAILED: 10/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Applicati n No. 09/483,766	Applicant(s) MAHE ET AL.	
	Examin r Blessing M. Fubara	Art Unit 1615	

-- The MAILING DATE f this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-13 and 15-17 is/are rejected.

7)☒ Claim(s) 14 is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☒ None of the CERTIFIED copies of the priority documents have been:

1.☒ received.

2.☐ received in Application No. (Series Code / Serial Number) _____ .

3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15)☒ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18)☐ Interview Summary (PTO-413) Paper No(s). _____ .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other: .

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
All three inventors failed to supply the date of execution of the declaration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of "glacier SG 809 A" in claim 3 is confusing and thus renders the claim indefinite. It appears that "glacier SG 809 A" is a trade name.

Claim 3 contains the trademark/trade name "glacier SG 809 A". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the

trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a fragrance and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 15-17 provide for the use of composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 15-17 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Objections

Claims 5, 7-15 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and cannot depend from other multiple dependent claim. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants in view of Koga (JP 10,231,238).

Applicants admit that menthyl lactate and menthol are used in cosmetic and pharmaceutical compositions. Applicants are also aware that menthol concentrations in compositions at the level (1.25% to 16%) recommended by the Food and Drug Administration (FDA), impart strong flavor and consumers do not appreciate the strong odor and thus such compositions. Applicants are also aware that menthol posses freshening and anti-irritant properties. See pages 1 to 3 of the disclosure.

Koga in JP 10,231,238 teaches a cosmetic composition that is prepared by adding 0.001-10.0 weight percent of menthol and at least one of menthyl lactate, menthyl glycoside menthyl hydroxybutyrate, menthoxypropanediol and menthoxyfurane (abstract).

Applicants are aware that high concentrations of menthol in a composition cause undesired response from consumers. Applicants are aware that menthol possesses anti-irritant properties. Koga in JP 10,231,238 teaches a cosmetic composition comprising lower concentrations of menthol than that recommended by FDA. . It is the examiner's position that the state of the art is such that one of ordinary skill in the art would know routine procedure for testing different concentrations ratios of menthol and menthyl lactate (or menthyl glycoside, menthyl hydroxybutyrate, menthoxypropanediol and menthoxyfurane) to provide a composition that is not irritating to the human body. It would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to employ ones knowledge of the sate of the

art in the manner taught by Koga. One having ordinary skill in the art would have been motivated to prepare a freshening cosmetic composition that has menthol and menthyl lactate, menthyl glycoside menthyl hydroxybutyrate, menthoxypropanediol or menthoxyfurane in the appropriate concentrations so that the composition is not irritating to the human body. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is not inventive over JP 10, 231,238 in the absence of a showing of criticality of the claimed concentrations of menthol and menthyl lactate.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler et al.

Fowler et al. discloses a cleansing composition comprising menthol, menthyl lactate, sodium lauryl sulfate, sodium laureth sulfate, cetyl dimethyl betaine, sodium cocoyl isethionate, glycerin, polyethylene glycols, fragrance, anti-oxidants, preservatives, polyquaternium-10, propoxylated glycerol, carboxymethyl cellulose and hydroxypropylcellulose. Fowler et al. teaches a cleansing composition comprising 0.1% to 10% menthol and menthyl lactate. It is the examiner's position that the state of the art is such that one of ordinary skill in the art would know routine procedure for testing different concentrations of menthol in combination with different concentrations of menthyl lactate or any of the other compounds listed by Fowler et al. to provide a composition that is not irritating to the human body. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Fowler et al. One having ordinary skill in the art would have been motivated to prepare the composition of Fowler et al. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine

experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is not inventive over the prior art in the absence of a showing of criticality.

Applicants' cooperation is requested in correcting any errors of which applicant may become aware in the specification. Applicants are also required to check the claims for other problems under 35 U.S.C. 112.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374. The examiner can normally be reached on Monday to Friday from 7 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600